REMARKS

Rejections under 35 U.S.C. § 103

Independent claims 1 and 35 were rejected as obvious based on U.S. patent application number 2004/0068542 (hereinafter *Lalonde*), U.S. patent number 7,206,814 (hereinafter *Kirsch*), and U.S. patent application number 2008/0040439 (hereinafter *Wang*). *Office Action,* 2. The Examiner further rejects claims 2, 6, 11, 16, 19-21, and 23-27 based on *Lalonde*, *Kirsch*, and *Wang* in further view of U.S. patent number 7,366,761 (hereinafter *Murray*). *Office Action*, 7.   In addition, claim 29 is rejected as obvious over *Lalonde*, *Kirsch*, and *Wang* in further view of U. S. patent application number 2005/0076240 (hereinafter *Appleman*). The Applicants respectfully traverse.

To support a conclusion that the claim would have been obvious requires that all the claimed elements were known in the prior art and that one skilled in the art could have combined those elements. See *KSR v. Teleflex*, 127 S.Ct. 1727, 1739 (2007); see also MPEP § 2143. The Applicants submit that the combination of *Lalonde*, *Kirsch*, *Wang*, *Murray*, and *Appleman* – individually or in any combination -- fail to disclose at least 'overriding the whitelist based on the score assigned to the address-domain pair, wherein the message is **classified as spam even though the domain of the message appears on the whitelist.'** See *Specification*, 7:14-16; 16:8-9 (describing that "[a] white list can be overridden if the IP address and domain based classification provides compelling evidence that the message was not really sent from the stated sender domain" and a "message may be classified as spam even if the user has that domain white listed, because of the strong evidence that that IP address is not a legitimate one").

The Examiner already admits that "*Lalonde*, *Kirsch*, and *Wang* do not teach overriding a white list." *Office Action*, 7. The Examiner therefore relies solely on *Murray* to teach the claimed override of the whitelist. The portion of *Murray* cited by the Examiner states that

"[i]n one embodiment, higher weight is given to manual (explicit) reversals of whitelist/blacklist status than implicit rankings." *Office Action*, 7 (citing *Murray* 18:38-40). The Applicants respectfully contend that a **reversal** of whitelist status is not the same as **overriding** the whitelist.

The cited "reversal" of *Murray* is explicitly described as concerning "if a message's whitelist/blacklist status changes" or "a message is moved from the whitelist to the blacklist or vice versa." *Murray*, 18:34-36. As such, *Murray*'s "reversal" of whitelist status results in the status of a message being changed to indicate inclusion in a blacklist instead of in the whitelist (or vice versa). In contrast, the claimed 'overriding' allows the domain of the message to **remain on the whitelist**. As described in the specification and generally understood by one having ordinary skill in the art, a whitelist "controls the disposition of such a message" identified by the whitelist as, for example, being "associated with known friends" and therefore "enjoy[ing] automatic acceptance as a result of the whitelist." See *Specification*, 5:20; 6:14-15; 7:1-2. When the whitelist is employed and not overridden, therefore, a message having a domain on the whitelist would "enjoy automatic acceptance" as a legitimate message. As claimed, the whitelist may be overridden to the extent that having a domain on the whitelist does not prevent a particular message from being classified as spam. Because *Murray* teaches only **changes** to whitelist status, *Murray* fails to teach the claimed whitelist override in which 'the message is classified as spam even though the domain of the message appears on the whitelist.'

Murray further fails to teach that its "reversal" of the whitelist is based on "the score assigned to the address-domain pair." Proper examination demands consideration of the claim as a whole, rather than isolated parts. See *Phillips v. AWH Corporation*, 415 F.3d 1303, 1313 (Fed. Cir. 2005); *see also ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed.Cir.2003) ("the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms"). The Applicants therefore submit that reading the claim language as a whole and in context must include consideration of the

explicit recitation that the claimed 'overriding' of the whitelist is based on a score that is assigned to an address-domain pair in which the score is based on classification variables that decay with time. Mere mention of "score" in *Murray* is not sufficient to teach the specifically claimed override of the whitelist based on address-domain pair score. For this additional reason, *Murray* fails to teach 'overriding the whitelist based on the score assigned to the address-domain pair.'

Appleman does not overcome the deficiencies of the *Lalonde, Kirsch, Wang,* and *Murray* disclosure in this regard.

In light of the foregoing, the Applicants contend that *Lalonde, Kirsch,* and *Wang* – individually or in any combination with *Murray* or *Appleman* -- fail to teach all the limitations of the independent claims. Further, as each dependent claim incorporates each and every element of the claim upon which it depends, the dependent claims are allowable for at least the same reasons.

Lack of Motivation to Combine

The Applicants note that pursuant to the Supreme Court's decision in *KSR v. Teleflex,* the Examiner must still provide some basis **for the combination** (*i.e.,* motivation) regardless of whether the elements were previously known to exist in the art. See *KSR,* 127 S.Ct. at. 1741 (emphasizing importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does"). Following *KSR,* the Federal Circuit further articulated that the requisite motivation underlying a conclusion of obviousness is a "motivation to combine **particular references** to reach the **particular claimed** method." *Innogenetics, NV v. Abbott Laboratories,* 512 F.3d 1363, 1373-74 n. 3 (Fed. Cir. 2008) (emphasis added).

The Examiner argues that the motivation to combine *Murray* with *Lalonde*, *Kirsch*, and *Wang* is to "increase the effectiveness of their system by filtering unwanted e-mails based on sender information." *Office Action*, 8. As such, the purported motivation relies on the lack of the ability to filter "unwanted e-mails based on sender information" in *Lalonde*, *Kirsch*, and *Wang* such that a person of ordinary skill in the art looking to achieve such ability must look to incorporate *Murray* into the combination.

Lalonde, however, explicitly teaches that a "blacklist of senders includes a list of all domain names that are likely to be a source of unwanted email" and "block[ing] emails which have been sent from a blacklisted server." *Lalonde*, [0042]. In addition, *Kirsch* explicitly teaches "filter[ing] e-mails by applying rules to identify and 'blacklist' (i.e., identifying certain senders or content, etc., as spam)." *Kirsch*, 1:52-54. Finally, *Wang* teaches "accept/reject determination is made by the accept/reject filter 23 on the basis of a sender penalty count status." *Wang*, [0017]. In short, each reference -- *Lalonde*, *Kirsch*, and *Wang* – already teaches "filtering unwanted e-mails based on sender information." As such, there is no reason for a person having ordinary skill in the art to combine yet another reference (*i.e.*, *Murray*) to achieve a feature that is already present in the combination of *Lalonde*, *Kirsch*, and *Wang*.

The Applicants therefore submit that the Exmainer's motivation for specifically combining *Murray* with the other references is to try to teach the claimed invention, which is the very definition of hindsight justification and therefore an impermissible basis for obviousness rejection.

CONCLUSION

The Applicants have evidenced the failure of *Lalonde*, *Kirsch,* and *Wang* – individually or in any combination with *Murray* or *Appleman* -- to disclose all the limitations of the independent claims, including at least 'overriding the whitelist based on the score assigned to the address-domain pair, wherein the message is classified as spam even though the domain of the message appears on the whitelist.' The requisite motivation to combine is also lacking.

Any claim dependent upon one of the aforementioned independent claims—either directly or via an intermediate dependent claim—is allowable for at least the same reasons as the claim from which it depends. As such, each and every one of the dependent claims of the present application are also in condition for allowance.

As all outstanding rejections are overcome, the Applicants respectfully contend that the application is in condition for allowance. The Examiner is invited to contact the Applicants' undersigned representative with any questions regarding the present application.

Respectfully submitted,
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